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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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VUONG, QUOCHIEU B				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/822,218

Applicant(s)

THOMAS ET AL.

Examiner

Quochien B. Vuong

Art Unit

2618

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 March 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5-8, 15, 17-24, 26-28 and 32-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5-8, 15, 17-24, 26 and 28 is/are rejected.
- 7) ☒ Claim(s) 27 and 32-38 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This action is in response to applicant's response filed on 03/19/2008. Claims 5-8, 15, 17-24, 26-28, and 32-38 are now pending in the present application. **This action is made final.**

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 5, 6, 15, 17, 18, 21-24, 26 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Swab et al. (US 6,929,365) in view of Horiguchi (US 7,031,667).

Regarding claim 15, Swab et al. (figures 1, 2a, and 3) disclose a pair of eyeglasses, comprising: a frame having a pair of arms and a pair of lens holders (figures 1 and 2a), one or both of the arms having an internal area; wireless communication circuitry (figure 3) provided within the internal area of one or both of the arms; at least one speaker (56) coupled to the wireless communication circuitry; at least one microphone (54) coupled to the wireless communication circuitry; at least one battery (52) for powering at least the wireless communication circuitry, wherein the at least one battery is provided within the internal area of at least one of the arms (column 4, lines 5-18; column 4, line 66- column 5, line 43; and column 5, line 66 – column 6, line 16). Swab et al. do not specifically disclose the pair of eyeglasses comprising at least one operation indicator configured to indicate an operation of the wireless communication circuitry, wherein the at least one operation indicator is at least partially internal to the frame, wherein the at least one operation indicator is controlled based on a monitored operational condition of the wireless communication circuitry, and wherein the at least one operation indicator being configured to indicate when the wireless communication is in use. However, Horiguchi disclose a wireless communication device (figure 2, portable telephone) comprising at least one operation indicator (light source) is controlled based on a monitored operational condition of the wireless communication circuitry and for indicating whether the wireless communication circuitry is in use (see

abstract; column 3, lines 28-45; and column 5, lines 16-58). Therefore it would have been obvious to one ordinary skill in the art at the time the invention was made to adapt the at least one operation indicator of Horiguchi to the internal frame of the eyeglasses of Swab et al. to provide a visual indication of the operating state of the communication circuitry of the eyeglasses to the user.

As to claims 5 and 6, Swab et al. disclose at least one speaker coupled to the arm of the eyeglasses (figure 8) (column 7, lines 11-23); and if not inherent it would be obvious for the at least one speaker of Swab et al. to be arranged as in claims in order to be in the arm of the eyeglasses and provide communication function to the user.

As to claim 17, Horiguchi discloses the at least operation indicator is a light source to provide the operation state and that the wireless communication circuitry is in use (see abstract; column 3, lines 28-45; and column 5, lines 16-58).

As to claim 18, Horiguchi discloses the operation indicator illuminates or not to indicate that whether a call using the wireless communication circuitry is ongoing or not (see abstract; column 3, lines 28-45; and column 5, lines 16-58). Therefore, it would have been obvious to adapt the teaching of Horiguchi and modify it in such a way that the operation indicator illuminates to indicate that a call using the wireless communication circuitry is ongoing to serve the same function as to notify the user that the call is on going or not.

As to claim 21, Swab et al. and Horiguchi disclose the eyeglasses of claim 15; in addition Swab et al. disclose wherein the at least one battery is provided within the internal area of a first of the arms. Swab et al. and Horiguchi do not specifically disclose

the eyeglasses further comprising a balancing weight provided within the internal area of at least one of the arms, and wherein the balancing weight is provided internal to a second of the arms so that the two arms are of substantially the same weight, and wherein the at least one battery is rechargeable. However, Swab et al. do disclose balancing weight for the eyeglasses frame (column 5, line 36-41) by putting battery on one arm and the other circuitry on the other arm. Therefore, it would have been obvious for one having ordinary skill in the art at the time the invention was made to put an additional balancing weight to one or the other arm when necessary for the same purpose of balancing the weight of the eyeglasses to provide comfort to the user.

As to claim 22, it would have been obvious for the at least one operation indicator to be provided at the front face of the frame of the eyeglasses of Swab et al. and Horiguchi in order to alert people that whether the wireless communication circuit is in used or not.

As to claim 23, Swab et al. disclose a Bluetooth module (figure 1, item 18) completely internal to the frame, and Horiguchi disclose an antenna (figure 2, item 2).

Regarding claim 24, Swab et al. (figures 1, 2a, and 3) disclose a method for operating a pair of eyeglasses having communication circuitry (column 4, lines 5-18; column 4, line 66- column 5, line 43; and column 5, line 66 – column 6, line 16). Swab et al. do not specifically disclose the pair of eyeglasses comprising an operation indicator and the steps of monitoring the wireless communication circuitry to determine an operational condition of the wireless communication circuitry; and controlling the operation indicator based on the operational condition of the wireless communication circuitry as determined by the monitoring, wherein the operational condition indicates at

least whether the wireless communication circuitry is in use. However, Horiguchi disclose a wireless communication device (figure 2, portable telephone) comprising monitoring the wireless communication circuitry to determine an operational condition of the wireless communication circuitry; and controlling the operation indicator (light source) for indicating whether the wireless communication circuitry is in use (see abstract; column 3, lines 28-45; and column 5, lines 16-58). Therefore it would have been obvious to one ordinary skill in the art at the time the invention was made to adapt the at least one operation indicator of Horiguchi to the method of Swab et al. to provide a visual indication of the operating state of the communication circuitry of the eyeglasses to the user.

As to claim 26, Horiguchi discloses wherein the operational condition indicates at least the wireless communication circuitry is operating on an incoming call (column 3, lines 28-45; and column 5, lines 16-58).

As to claim 28, Horiguchi discloses wherein the operation indicator is a light source (column 3, lines 28-45; and column 5, lines 16-58).

4. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Swab et al. in view of Horiguchi above and further in view of Wareen (US 7,013,009).

Regarding claim 7, Swab et al. and Horiguchi disclose the pair of eyeglasses of claim 1. Swab et al. and Horiguchi do not disclose wherein the at least one speaker is a bone-type speaker. However, Warren discloses eyeglasses with wireless communication features including bone-type speaker (see figure 2, speaker 24) (column

5, lines 1-16). Therefore, it would have been obvious for one having ordinary skill in the art at the time the invention was made to adapt the bone-type speaker of Warren to the eyeglasses of Swab et al. and Horiguchi for miniature and compact design.

5. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Swab et al. in view of Horiguchi above and further in view of Jesiek (US 6,010,216)

Regarding claim 8, Swab et al. and Horiguchi disclose the pair of eyeglasses of claim 1. Swab et al. and Horiguchi do not disclose wherein the at least one battery is rechargeable. However, Jesiek discloses a hands free two-way radio communications in the eyeglasses with rechargeable batteries (column 1, lines 46-61; and figures 1 and 2). Therefore, it would have been obvious for one having ordinary skill in the art at the time the invention was made to adapt the rechargeable batteries of Jesiek to the eyeglasses of Swab et al. and Horiguchi in order to save cost by reusing the rechargeable batteries. And since the eyeglasses of Swab et al., Horiguchi, and Jesiek comprising the rechargeable batteries, it would be obvious for the eyeglasses to include a power adapter connector in order to charge the rechargeable batteries without removing the batteries from the eyeglasses.

6. Claims 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Swab et al. in view of Horiguchi and further in view of Spitzer (US 6,091,546).

Regarding claims 19 and 20, Swab et al. and Horiguchi do not specifically disclose the eyeglasses further comprising a position sensor provided within the internal area of at least one of the arms. However, Spitzer discloses an eyeglasses interface

system comprising a position sensor provided within the internal area of at least one of the arms (column 11, lines 11-23). Therefore, it would have been obvious to adapt the position sensor of Spitzer to the eyeglasses of Swab et al. and Horiguchi in order to provide the location information to the user.

Allowable Subject Matter

7. Claims 27 and 32-38 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

8. Applicant's arguments filed 03/19/2008 have been fully considered but they are not persuasive.

Regarding claims 15 and 24, Applicant argues that Swab et al. in view of Horiguchi fail to disclose "at least one operation indicator is controlled based on a monitored operational condition of the wireless communication circuitry and at least one operation indicator configured to indicate when the wireless communication circuitry is in use". The examiner, however, does not agree with the Applicant. Applicant's attention is directed to Horiguchi (see abstract; column 3, lines 28-45; and column 5, line 16-58) which discloses an operation indicator (lamp 1) is controlled based on a monitor operational condition of the wireless communication circuitry and illuminates when the

portable phone is functioning in a noncommunicative mode and not illuminate when the portable phone is functioning in a communicating mode (i.e., in-use).

Further more, in response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, one of ordinary skill in the art would be motivated to adapt only the mode indicating lamp of Horguchi to the eyeglasses of Swab et al. for indicating whether the wireless communication circuitry is in used or not. And it also would be obvious for the indicator to be partially internal to the frame of the eyeglasses in order for the user to see.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

Art Unit: 2618

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Quochien B. Vuong whose telephone number is (571) 272-7902. The examiner can normally be reached on M-F 9:30-18:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nay Maung can be reached on (571) 272-7882. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Quochien B Vuong/
Primary Examiner, Art Unit 2618